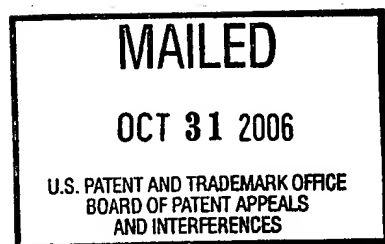


The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES



Ex parte ALBERT BAUER

Appeal No. 2006-0278
Application No. 08/998,507
Technology Center 3700

Before FRANKFORT, BAHR and LEVY, *Administrative Patent Judges*.
BAHR, *Administrative Patent Judge*.

REMAND TO THE EXAMINER

This application is remanded to the examiner, pursuant to 37 CFR § 41.50(a)(1), for appropriate action with regard to the following issues.

This panel issued an order to appellant under 37 CFR § 41.50(d) (mailed June 9, 2006) in which we required clarification from appellant as to whether the recitation “means for regulating an increase in pressure in the at least one room relative to an outside pressure, to vary the room pressure in correspondence to the selected room temperature” is a means-plus-function recitation under 35 U.S.C.

§ 112, sixth paragraph, and, in particular, whether the language “to vary the room pressure in correspondence to the selected room temperature” is part of the function of the means recitation or simply a statement of intended use. We further required appellant to identify the structure described in appellant’s specification that corresponds to such means-plus-function, if the above-discussed limitation is a means-plus-function limitation.

In a response filed July 25, 2006, appellant confirmed that the language at issue is a means-plus-function recitation and that the particular language “to vary the room pressure in correspondence to the selected room temperature” is “part of the means plus function recitation, since this confirms the specific function of the means, not merely an intended use, as the means must provide for the dynamic inter-relationship of room temperature and pressure” (response, p. 1). We understand appellant’s response to be an argument that the “means for regulating an increase in pressure in the at least one room relative to an outside pressure, to vary the room pressure in correspondence to the selected room temperature” recitation is to be interpreted as requiring structure that regulates a pressure increase in the room

relative to an outside pressure so as to vary the room temperature in correspondence to (i.e., as a function of) the selected room temperature.

As for identification of the structure described in appellant's specification for performing this pressure regulation to vary the room temperature in correspondence to the selected room temperature, appellant attempts to address this on pages 3-5 of the response. In particular, appellant points out that the difference ΔT_N between the selected room temperature T_{SOLLN} and the measured room temperature T_{ISTN} is utilized not only to control the supply air temperature T_{ZU} but also to initiate a pressure change in the room (p. 3). The pressure change to which appellant is referring is in the supply air pressure P_{ZU} , not the room pressure. Appellant's response (p. 3) refers to P_{ZU} as the room pressure, but, in fact, P_{ZU} as described in appellant's specification (e.g., pp. 21-22) is the supply air pressure. As described on pages 21-22 of appellant's specification, it appears that the desired supply air pressure increase $\Delta P = P_{ZUSOLL} - P_{ZUIST}$, where P_{ZUSOLL} is the desired supply air pressure and P_{ZUIST} is the actual measured supply air pressure and ΔP is a function of T_{ISTN} and T_{SOLLN} , is used to control the supply air motor 15 and exhaust air motor 16. In particular, appellant's specification states, in the sentence bridging pages 21-22, "With the **corresponding** regulating circuit by an exhaust air motor 16 in the exhaust air channel 11, a subpressure P_{AB} is generated which, for the **maintaining** of a **predetermined** excess pressure in the rooms, draws off a corresponding volume of air" (emphasis added). It would thus appear that the pressure control adjusts the supply air motor 15 and exhaust air motor 16 **correspondingly** to supply

and remove the same volume of air, thereby **maintaining** the room pressure, not varying it, as recited in claim 44.

As explained on pages 22-23 of appellant's specification, the supply and exhaust throttle valves 60, 61 are controlled using the desired temperature T_{RAUMSOLL} , the actual measured room temperature T_{RAUMIST} , and supply air temperature T_{ZU} , "as well as in dependence on the supply air pressure P_{ZU} and/or the speed of the supply air motor." On page 23, the specification explains that the desired value (presumably speed) for the exhaust motor 16 is calculated in dependence on the outside temperature "in which operation this desired value forms a room excess pressure P_{DIFFSOLL} established in respect to the outside pressure P_{A} in dependence on the outside temperature." It is not exactly clear what is meant by this disclosure. Even assuming, however, that the speed of the exhaust motor 16 is regulated on the basis of the outside pressure and temperature, perhaps somehow in addition to the regulation of the exhaust motor 16 "corresponding" to that of the supply motor 15, as discussed above (specification, pp. 21-22), to effect a room excess pressure which in effect varies the room pressure, such room pressure variation is in correspondence to outside temperature and pressure, not in correspondence to the selected room temperature, as called for in the means-plus-function recitation at issue in claim 44.

In light of the above, we do not find structure disclosed in appellant's specification for causing a variation in room pressure in correspondence to the

selected room temperature so as to meet the means-plus-function recitation of claim

44. On page 5 of the response, appellant states:

The regulators, controllers, temperature and pressure sensors, valves, motor controls, etc, are structures that **may** [emphasis added] be used to perform the function specified, in various combinations, arranged for utilizing room temperature as a control signal for effecting pressure variations in a room. Various ways of varying the room pressure are discussed in the specification, such as by varying the supply air motor speed, opening or closing a throttle valve to supply more or less air to the room, opening or closing an exit valve, controlling both vanes if both are present, or by varying the motor speed of an exhaust air motor, if one is used. Because there are many ways in which to accomplish the stated function, means plus function language is appropriate to use in claim 44.

As our reviewing court stated in *In re Dossel*, 115 F.3d 942, 946, 42 USPQ2d 1881, 1885 (Fed. Cir. 1997) (quoting *In re Donaldson Co.*, 16 F.3d 1189, 1195, 29 USPQ2d 1845, 1850 (Fed. Cir. 1994)),

[a]lthough paragraph six statutorily provides that one may use means plus function language in a claim, one is still subject to the requirement that a claim "particularly point out and distinctly claim" the invention. Therefore, if one employs means plus function language in a claim, one must set forth in the specification an adequate disclosure showing what is meant by that language. If an applicant fails to set forth an adequate disclosure, the applicant has in effect failed to particularly point out and distinctly

claim the invention as required by the second paragraph of section 112.

Appellant has not pointed to any disclosure in the specification that room temperature is actually varied in correspondence to the selected room temperature, much less any disclosure of specific structure (sensors, valves, switches, motors **and** control circuit) for actually performing such function. Appellant's position appears to be that, because appellant has disclosed pressure and temperature regulators, supply and exhaust motors and throttle valves for controlling air flow and temperature and pressure sensors for measuring temperature and pressure, which, if programmed appropriately, **may** be used to perform the function specified, this satisfies appellant's obligation to set forth in the specification an adequate disclosure showing what is meant by the claim language at issue, regardless of whether the structure is disclosed as being programmed to so perform. At the same time, however, appellant argues that the disclosure of regulators, supply and return blowers and blower controls, thermostatically controlled damper control boxes and pressure transducers in Johannsen's pressure control system is insufficient to meet the "means for regulating ..." limitation because, according to appellant, the blowers and damper control boxes of Johannsen are operated in such a manner that room pressure is kept constant (response, p. 8). It is difficult, in the face of appellant's arguments as to why the disclosed structure of Johannsen is insufficient to satisfy this claim recitation, to understand how the structure in appellant's specification relied upon by appellant is adequate to show what is meant

by that claim language so as to satisfy the requirement in 35 U.S.C. § 112, second paragraph, to particularly point out and distinctly claim the invention.

Before a determination can be made as to whether the subject matter of claim 44, and the claims depending therefrom, is anticipated by Johannsen or unpatentable over Johannsen in view of the other references relied upon by the examiner, it is imperative that the metes and bounds of the claims, including the “means for regulating ...” recitation of claim 44, be ascertained. This application is therefore being remanded to the examiner to review the seemingly inconsistent arguments of appellant in the response to our order, in light of appellant’s specification, in order to make a determination, on the record, as to the scope of the “means for regulating ...” recitation of claim 44. In so doing, the examiner must identify the structure disclosed in appellant’s specification for performing the recited function. If the examiner cannot identify such structure, the examiner should consider whether a rejection under 35 U.S.C. § 112, second paragraph, is appropriate, in accordance with the reasoning of *Dossel* quoted above. If, on the other hand, the examiner is able to identify structure disclosed in appellant’s specification for performing the entirety of the function of the “means for regulating ...” recitation, the examiner should make clear on the record exactly what that structure is and where it is disclosed for performing the recited function. Further, if the rejections under 35 U.S.C. § 102(b) and § 103(a) are maintained, the examiner must identify the structure of Johannsen that meets the “means for regulating ...”


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recitation, explaining why it is the structure disclosed in appellant's specification, or an equivalent thereof.

This remand to the examiner pursuant to 37 CFR § 41.50(a)(1) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)) is made for further consideration of a rejection. Accordingly, 37 CFR § 41.50(a)(2) applies if a supplemental examiner's answer is written in response to this remand by the Board.

REMANDED

Charles E. Frankfort
CHARLES E. FRANKFORT
Administrative Patent Judge


JENNIFER D. BAHR
Administrative Patent Judge


STUART S. LEVY
Administrative Patent Judge

) BOARD OF PATENT
) APPEALS
) AND
) INTERFERENCES

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